

REMARKS

Claims 14-31 and 37-47 are pending in the present application.

In the present Office Action, claims 14-31 and 37-47 are rejected under 35 U.S.C. § 102(e) as being anticipated by Miller et al. (US006421707B1).

Independent claim 15 recites a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device; and a data transmitting device transmitting at least a portion of the data of the E-mail received by the E-mail receiving device to the image output device selected by the selecting device.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In making the rejection of claim 15, the Examiner asserts that the claimed notifying device that sends an E-mail to the portable terminal containing a notification of the image output device selected by the selecting device is disclosed by Miller at column 1, lines 47-58, column 2, lines 58-64, column 5, lines 35-49, column 6, lines 14-19 and column 9, lines 40-46. The Examiner goes on to explain at page 5, second bullet point, that Miller teaches an environment where e-mail addressed to a mobile subscriber is received at the service controller, a receipt notification is selectively generated and delivered to the addressee and finally the intended e-mail is displayed to the subscriber or output to a device such as a facsimile. The Examiner then quotes a substantial portion of column 3, lines 33-38.

After carefully considering the Examiner's arguments on pages 24-28 of the Office Action, the characterization of the Miller system, the quoted Column 3 language, and the other cited column and lines, Applicant was unable to find the claimed feature of a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device in the Miller patent.

Miller merely sends a receipt notification, nothing more. For example, column 1, lines 47-58, in particular, lines 54-58 state "The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network." (Emphasis added). There is no mention of an e-mail containing a notification of the image output device selected by the selecting device being sent to the portable terminal unit.

Column 2, lines 52-64 describe subsystems and delivery systems that are suitable for implementing the system architecture. Column 5, lines 35-49 describes the process of pressing the content soft key with reference to Figure 4(i).

Column 6, lines 14-19 describe the hypothetical user entering a destination fax number to which a graphics file is to be sent.

Finally, column 9, lines 40-46 discuss that filtering and forwarding rules are flexible, and permit filtering and forwarding of mail messages in any manner capable of being specified as a rule. There is no disclosure or suggestion of sending an e-mail containing a notification of the image output device selected by the selecting device in any of the above citations or in column 3, lines 33-38 of the Miller patent.

Independent claims 37-43 recite a similar notifying feature as independent claim 15, and the above arguments apply to them as well. Since each and every element as set forth in the claims is not disclosed or suggested in the Miller patent, Applicant respectfully submits that claims 15 and 37-43 are not anticipated by the Miller patent.

Turning to the rejection of claims 14, 31, and 44-46 on page 11 of the Office Action, the claimed E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices of claim 14 is addressed. The Examiner asserts that the same citations, column 1, lines 47-58, column 2, lines 58-64, column 5, lines 35-49, column 6, lines 14-19 and column 9, lines 40-46, as those used to reject the notifying device recited in claim 15 also disclose the E-mail transmitting device.

However, as in the rejection of claim 15, the claimed feature of an E-mail identifying multiple prospective image output devices is not disclosed. None of the citations describe the claimed step of transmitting an E-mail identifying multiple prospective image output devices, only the selective sending of a receipt notification.

The system of Miller does not provide a E-mail identifying multiple prospective image output devices as recited in independent claim 14. As stated in column 1, lines 54-58 of the Miller patent, "The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network." (emphasis added). This is not the same as the claimed feature.

Independent claim 31 recites a similar E-mail transmitting device as independent claim 14.

Independent claim 44 recites a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least a part of the E-mail is to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination. (Emphasis added). The cited portions of the Miller patent do not disclose or suggest a processor for generating at least one E-mail containing information on at least one output device to which at least part of the E-mail is to be output as recited in independent claim 14.

For at least the above reasons, the Miller patent does not anticipate claims 14, 31 and 44-47, and the rejections of those claims should be withdrawn.

Claims 14-31 and 37-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Theimer et al. (US005493692A).

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reason as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references", Ex Parte Clapp, 227 USPQ 972, 973(Bd. Pat. App. & Inter. 1985).

As stated at page 17 of the Office Action, the Examiner is relying on the Thiemer patent for its alleged disclosure of the claimed features of a location information acquiring device and a selecting device. However, the Thiemer patent

does not overcome the deficiencies of the Miller patent outlined above. Neither the Miller patent nor the Theimer patent, either individually or in combination, disclose or suggest all of the features recited in independent claims 14, 31 and 44 and those that depend therefrom. For example, neither Miller nor Theimer disclose or suggest, individually or in combination, the feature of transmitting or generating an E-mail identifying multiple prospective image output devices or containing information on at least one output device to which at least part of the E-mail is to be output.

As for independent claims 15 and 37-43, these claims recite a feature of a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device, or sending an E-mail to said destination containing a notification of the selected image output device. Neither the Miller patent nor the Theimer patent, either individually or in combination, disclose or suggest the above cited features in combination with the other features recited in independent claims 15 and 37-43 and those that depend therefrom.

Claim 47, which depends on independent claim 15, is rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Theimer et al. (US005493692A) and further in view of Glorikian.

The Office cites the Glorikain patent as disclosing the claimed feature of the selecting device automatically selects one of said multiple image devices on the basis of the location information of said portable terminal unit acquired by said location acquiring device. However, the Glorikian patent does not overcome the deficiencies of the Miller and Theimer patents with respect to the feature claimed in

claim 15 of a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by the selecting device.

Therefore, the Glorikian, Miller and Theimer patents, either individually or in combination, do not disclose or suggest all of the features recited in dependent claim 47.

Applicant requests withdrawal of the rejection of claims 14-31 and 37-47 and notification of allowance over the applied prior art.

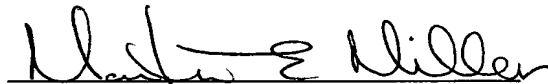
Should any questions arise in connection with this application, or should the Examiner believe a telephone conference would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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